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TRANSMITTAL LETTER
(General - Patent Pending)

Docket No.
IPCP:107US
In Re Application of: **COLSON et al.**

| Application No. | Filing Date | Examiner | Customer No. | Group Art Unit | Confirmation No. |
|-----------------|-------------|----------------|--------------|----------------|------------------|
| 09/931,492 | 08/16/2001 | John M. Winter | 24041 | 3621 | 4008 |

Title: **GLOBAL INFORMATION NETWORK PRODUCT PUBLICATION SYSTEM**COMMISSIONER FOR PATENTS:

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/C. Paul Maliszewski/

Dated: Jan. 3, 2008

Signature

C. Paul Maliszewski
 Registration No. 51,990
 Simpson & Simpson, PLLC
 5555 Main Street
 Williamsville, NY 14221-5406
 Telephone No. 716-626-1564
 Facsimile No. 716-626-0366

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/C. Paul Maliszewski/

*Signature of Person Mailing Correspondence***C. Paul Maliszewski***Typed or Printed Name of Person Mailing Correspondence*

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

U.S. Patent Application No.: 09/931,492

Confirmation No.: 4008

Applicant(s): COLSON, Thomas J. et al.

Filed: 08/16/2001

For: **GLOBAL INFORMATION NETWORK PRODUCT
PUBLICATION SYSTEM**

TC/Art Unit: 3621

Examiner: John M. WINTER

Docket No.: IPCP:107US

Customer No.: 24041

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/C. Paul Maliszewski/

C. Paul Maliszewski

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REPLY BRIEF UNDER 37 C.F.R. § 41.41

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Honorable Sir:

This Reply Brief is in response to the Examiner's Answer dated November 5, 2007 for the above referenced application.

Attorney Docket No. IPCP:107US
U.S. Patent Application No. 09/931,492
Reply Brief
Date: January 3, 2008

STATUS OF CLAIMS

The application originally contained 44 claims.

Claims 1, 12, 23, and 34 have been cancelled.

Claims 17, 18, 39, and 40 are objected to.

Claims 2-11, 13-16, 19-22, 24-33, 35-38, and 41-44 stand as finally rejected.

Claims 2-11, 13-16, 19-22, 24-33, 35-38, and 41-44 are the subject of this Appeal.

Attorney Docket No. IPCP:107US
U.S. Patent Application No. 09/931,492
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GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether Claims 2-11, 13-16, 19-22, 24-33, 35-38, and 41-44 are unpatentable under 35 U.S.C. §103(a) over U.S. Patent No. 6,339,767 (Rivette et al.) in view of U.S. Patent No. 6,154,725 (Donner) and further in view of U.S. Patent No. 6,401,206 (Khan et al.)?

ARGUMENT

1. Whether Claims 2-12, 14-24, 26-34, 36-43, and 46-50 are non-obvious under 35 U.S.C. §103(a) to a person having ordinary skill in the art at the time the invention was made and therefore patentable over U.S. Patent No. 5,295,052 (Chin) in view of U.S. Patent No. 5,076,660 (Messinger)?

A.) Summary of the Rejection: In the Final Office Action dated 12/15/2006 (hereinafter referred to as "the Office Action," the Examiner rejected Claims 2-11, 13-16, 19-22, 24-33, 35-38, and 41-44 as being unpatentable under 35 U.S.C. §103(a) over U.S. Patent No. 6,339,767 (Rivette et al.) in view of U.S. Patent No. 6,154,725 (Donner) and further in view of U.S. Patent No. 6,401,206 (Khan et al.).

The Examiner included U.S. Patent No. 6,947,909 (Hoke Jr.) in the header for the rejection, but in the next to last line on page 2 of the Office Action, stated that this reference had been withdrawn. The Hoke reference was not mentioned in the Examiner's arguments. Therefore, Appellants have not addressed the Hoke reference.

The Examiner stated: "Rivette et al. ('767) discloses a method of publishing a product document, said method comprising the steps of:

providing a searchable document database and a publication Web site in communication with a document database; (Figures 2 and 3)

Rivette et al. ('767) does not explicitly disclose "electronically receiving said product document transmitted by a client's computer, and publishing said client document by adding said client document to said document database", Donner ('725) discloses "electronically receiving said product document transmitted by a client's computer,(Figure 1) and publishing said client document by adding said client document to said document database".(Figure 2) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Rivette et al. ('767) method with the Donner ('725) method in order in order to decrease the latency in document processing by utilizing electronic transmission means.

Rivette et al. ('767) does not explicitly disclose "Digitally notarizing said product document and obtaining a document notarization record, said document notarization record including a timestamp and a digital fingerprint", Khan et al. ('206) discloses digitally notarizing said product document and obtaining a document notarization record, said document notarization record including a timestamp and a digital fingerprint(Column 4, lines 45-63 [utilizes timestamp]; Abstract [discloses notary function] Figure 6, [digital fingerprint]) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Rivette et al. ('767) method with the Khan et al. ('206) method in order in order to decrease fraud by adding elements to verify authenticity such as time stamps.

Rivette et al. ('767) does not explicitly disclose "database is publically (sic) accessible", Donner ('725) discloses "database is publically (sic) accessible".(Figure 2; column 5, lines 44-57) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Rivette et al. ('767) method with the Donner ('725) method in order in order to form an IP portfolio utilize materila (sic) in the public domain."

B) Response to Arguments in Examiner's Answer

1) Claim 11

a) Rivette does not teach a publicly accessible and searchable database

Claim 11 recites: "providing a searchable document database and a publication Web site in communication with said document database, *where said database is publicly accessible*;" (emphasis added)

The Examiner stated: 'The Appellant states that Rivette does not teach a searchable database in communication with a publication Web site; The Examiner responds that this feature is clearly show by figure 3 of the Rivette reference; web server (element 310) publishes data from Databases (element 316) via Enterprise server (element 314). The Examiner further states that all databases are inherently searchable, Rivette sates that his invention is capable of "patent mapping, inventor patent count etc.. . the Examiner submits that these functions would be impossible without some type of searching capability."

The Examiner has failed to address the limitation that the database is publicly accessible. It is understood that a database is inherently searchable; however, Claim 11 recites the database being publicly accessible.

In fact, in the Office Action, the Examiner stated: "Rivette et al. ('767) does not explicitly disclose "database is publically (sic) accessible"

The crux of the Examiner's position regarding the public accessibility of Rivette was presented during a September 12, 2006 telephonic conference with the Examiner (as recorded in the Request for Reconsideration dated September 26, 2006), during which the relevance of Rivette to the above claim limitation was discussed. The Examiner asserted that Rivette teaches a publicly accessible database, based on the fact that Rivette shows an HTTP network in Figure 3. That is, an HTTP network is necessarily publicly accessible. However, the undersigned pointed out that the HTTP protocol is used in both public and non-public (i.e., controlled access) networks. That is, the use of HTTP protocol in a network does not mean that the network is publicly accessible. That is, the use of HTTP protocol is irrelevant to the issue of public accessibility. Alternately stated, the use of HTTP protocol cannot be used to determine if a system is public or non-public.

Further, as pointed out in the Brief on Appeal: Rivette is concerned with processing data; Rivette contains no suggestion regarding publication, for example, as shown in col. 10, lines 59-67 of Rivette; and the present invention is meant to be a very public and accessible process.

Thus, Rivette does not teach, suggest, or motivate providing a searchable document database and a publication Web site in communication with a document database, where the database is publicly accessible.

b) Rivette teaches against a publicly accessible and searchable database

The Examiner stated: "The Examiner responds that all databases are inherently searchable, the Appellants arguments appear to be directed towards whether the database is publically accessible, which is a feature disclosed by the Donner reference. Rivette states that his invention

is capable of "patent mapping, inventor patent count etc.. . the Examiner submits that these functions would be impossible without some type of searching capability."

The Examiner's argument is directed to Donner, not Rivette. The determination of whether Rivette teaches against a claim limitation has nothing to do with Donner. For example, assuming *arguendo* that Donner teaches searching a publicly accessible database as recited in Claim 11, which is not true, this has no bearing on Rivette's teachings. The Examiner has provided no arguments to refute Appellants' assertion that Rivette teaches against the claim limitations.

Regarding Donner, the Examiner originally cited Fig. 2 and col. 5, lines 44-57 with respect to the above claim limitation in the Office Action dated August 25, 2006. The cited lines teach that Donner's system can access other publicly accessible databases such as Lexis Nexis. Donner is not teaching that his database is accessible. The accessibility of a database in a network cannot be determined from the fact that the network can itself access a publicly accessible database. For example, a publicly inaccessible system can access a publicly accessible database while remaining publicly inaccessible itself.

c) Donner does not teach electronically receiving a product document

The Examiner stated: "The Appellant states that Donner does not teach receiving a product document The Examiner submits that as per column 5, lines 1-44 of the Donner reference, the client transmits information regarding an intellectual property portfolio to a database access device. Examiner submits that "intellectual property portfolio" could be construed as "a product document", and it is clearly received by the database access device."

Donner teaches transferring information, not a portfolio. In fact, Donner teaches that a user inputs the information, presumably by hand. That is, Donner teaches a user, already within his invention system, inputting patent numbers to initiate a search of publicly accessible databases such as DIALOG, for example, Fig. 2, and col. 5, lines 10-17. There is no teaching that Donner's system electronically receives a document. There is no teaching as to how the user has obtained the numbers or other data to be input. In fact, since the user must input the information

it is clear that Donner's system has not received a document with the information that must be inputted by the user.

d) Rivette does not teach publishing a product document

The Examiner stated: "The Appellant states that Donner does not publish a product document. Examiner submits that this feature is clearly show by figure 3 of the Rivette reference; webserver (element 310) publishes data from Databases (element 316) via Enterprise server (element 314)."

As Appellants have shown *supra*, the database and network taught by Rivette are not publicly accessible. Therefore, any movement of data from the database 316 by network 312 is not public and does not constitute publication.

e) There is no motivation to combine the references

The Examiner stated: "The Appellant states that there is no motivation to combine Rivette and Donner The Examiner responds that the Appellants arguments are foreclosed in view of *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1395, Where, as here "[an application] claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result," In the instance of the present invention the Examiner submits that the combination of the prior are references yields a predictable result."

The Examiner's argument assumes that Rivette, Donner, and Khan teach all the elements of Claim 11. Appellants have shown *supra* that this is not true. Rivette, Donner, and Khan fail to teach, suggest, or motivate at least: a publicly accessible and searchable document database and a publication Web site in communication with the document database; electronically receiving a product document transmitted by a client's computer; publishing the product document to establish a bar to patentability of inventions practiced in the product; and notarizing the product document. In fact, Appellants have shown that Rivette teaches against a publicly accessible and searchable database and that Khan teaches against the invention recited in Claim 11.

f) The Examiner has applied impermissible hindsight

The Examiner stated: "The Appellant states that the Examiner has applied impermissible hindsight, there is no teaching, suggestion, or motivation in the cited references to modify Rivette to form the claimed invention, nor is there any convincing reason as to why an artisan would be motivated to combine the references. The Examiner responds that the Appellants arguments are foreclosed in view of *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1395, Where, as here "[an application] claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result," In the instance of the present invention the Examiner submits that the combination of the prior art would have been obvious to a person having ordinary skill in the art at the time of the invention."

The Examiner's argument assumes that Rivette, Donner, and Khan teach all the elements of Claim 11. Appellants have shown *supra* that this is not true. Rivette, Donner, and Khan fail to teach, suggest, or motivate at least: a publicly accessible and searchable document database and a publication Web site in communication with the document database; electronically receiving a product document transmitted by a client's computer; publishing the product document to establish a bar to patentability of inventions practiced in the product; and notarizing the product document. In fact, Appellants have shown that Rivette teaches against a publicly accessible and searchable database and that Khan teaches against the invention recited in Claim 11.

g) Khan does not digitally notarize a document

The Examiner stated: "The Appellant states that Khan does not digitally notarize a product document with a timestamp and a digital fingerprint The Examiner responds that this feature is explicitly disclosed by Khan as stated in the prior rejection. Specifically at column 4, lines 45-63 Khan states "A series of techniques can be used for the person's identity verification. First the cryptographic digital signature is verified which establishes the integrity of the document, and ensures non-repudiation of origin to the extent that it was signed by the holder of the private key. A time stamp or random number is used to establish that the document is not a duplicate presented as an original. In case of a dispute, digital identity marks, which are

functions of the document and the personal identifiers, are used to verify that the digital signature indeed made the signature impression on the accompanying document."

The Abstract and col. 4, lines 45-63 of Khan teach using a personal public identity with respect to electronically signing a document. Khan does not teach, suggest, or motivate the document being a product document. In fact, signing a product document makes no sense. An electronic signature would only be applicable to a personal communication of some sort, for example, a letter, legal document, or memo. Khan reinforces the teaching of the document being a personal communication in Figures 6 and 7, which show a Notary-Public key. Clearly, a Notary Public would have no function with respect to a product document. Since Khan does not teach, suggest, or motivate a product document, Khan cannot teach notarizing a product document.

h) Khan teaches against the invention recited in Claim 11

The Examiner stated: "The Appellant states that Khan teaches against the invention recited in Claim 11; The product document of Claim 1 is placed in a publicly accessible database and is meant to be disseminated to and viewed by the public. Confidential and proprietary information by definition cannot and is not made public. In virtually all cases, personal information is meant to remain non-public and typically, legal information also is kept confidential. The Examiner responds that although in part Khan is directed towards protection of confidential and proprietary information, another aspect of the invention is "document and digital identity verification. (abstract). The Examiner contends that the feature of authenticating a document using a digital signature is equivalent to the feature of claim 11. A person having ordinary skill in the art at the time of the invention would have considered the feature disclosed by Khan to be adaptable to any type of information system, public or private.

Appellants note that the phrase: "The product document of Claim 1 is placed in a publicly accessible database and is meant to be disseminated to and viewed by the public" quoted by the Examiner is not from Appellants' arguments. Assuming *arguendo* that portions of Khan teach the publication process recited in Claim 11, which is not true, portions of Khan still teach against the invention in Claim 11. There is no necessity for every teaching of Khan to be against the

claimed invention. Further, the fact that Khan teaches “document and digital identity verification” does not mean that this process is public. Actually, such verification makes complete sense in the confidential process taught by Khan. Further still, Appellants have shown that the process and document taught in Khan are not analogous to the product document recited in Claim 11.

i) There is no motivation to combine Rivette and Khan

The Examiner stated: “The Appellant states that there is no motivation to combine Rivette and Donner The Examiner responds that the Appellants arguments are foreclosed in view of KSR, 127 S.Ct. at 1740, 82 USPQ2d at 1395, Where, as here “[an application] claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result,” In the instance of the present invention the Examiner submits that the combination of the prior are references yields a predictable result.”

The Examiner’s argument assumes that Rivette, Donner, and Khan teach all the elements of Claim 11. Appellants have shown *supra* that this is not true. Rivette, Donner, and Khan fail to teach, suggest, or motivate at least: a publicly accessible and searchable document database and a publication Web site in communication with the document database; electronically receiving a product document transmitted by a client’s computer; publishing the product document to establish a bar to patentability of inventions practiced in the product; and notarizing the product document. In fact, Appellants have shown that Rivette teaches against a publicly accessible and searchable database and that Khan teaches against the invention recited in Claim 11.

For all the reasons noted above, Claim 11 is patentable over the cited references. Claims 2-10, 13-16, and 19-22, dependent from Claim 11, enjoy the same distinction with respect to the cited references.

“If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious.” *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

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2.) Claim 33

The Examiner stated: "Claim 33 is in parallel with claim 11 and rejected for the same reasons." Therefore, the arguments presented *supra* with respect to Claim 1 are applicable to Claim 33 and Claim 33 also is patentable over the cited references. Claims 24-32, 35-38, and 41-44, dependent from Claim 33, enjoy the same distinction with respect to the cited references.

"If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious." *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

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CONCLUSION

For the reasons set forth above, Appellants respectfully submit that Claims 2-11, 13-16, 19-22, 24-33, 35-38, and 41-44 are non-obvious under 35 U.S.C. §103(a) over U.S. Patent No. 6,339,767 (Rivette et al.) in view of U.S. Patent No. 6,154,725 (Donner) and further in view of U.S. Patent No. 6,401,206 (Khan et al.) to a person having ordinary skill in the art at the time the invention was made and therefore patentable over the cited references.

Accordingly, Appellants prays that this Honorable Board will reverse the Examiner's rejection of Claims 2-11, 13-16, 19-22, 24-33, 35-38, and 41-44.

Respectfully submitted,

/C. Paul Maliszewski/

C. Paul Maliszewski
Registration No. 51,990
CUSTOMER NO. 24041
Simpson & Simpson, PLLC
5555 Main Street
Williamsville, NY 14221-5406
Telephone No. 716-626-1564

Dated: January 3, 2008
CPM/